

Appl. No. : 08/779,457  
Filed : January 7, 1997

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REMARKS

Claims 1-8, 11-12, and 22 and 25-29 and 40-42 are currently under consideration. Claims 1, 2 and 4 are amended herein. The amendments do not add new matter. Support for the amendment to claim 1 can be found, for example, in the Specification at page 4, lines 4-8 and page 66, lines 20-25. Claims 2 and 4 have been amended in view of the changes to claim 1. The changes made to the Specification and Claims by the current amendment, including deletions and additions, are shown herein with deletions designated with a strikethrough and additions underlined.

The basis for the amendment to the specification is discussed below.

Rejections under 35 U.S.C. §112, first paragraph

Claims 1-8, 11-12, 22, and 25-29 stand rejected because the Examiner objected to the insertion of material describing a method for screening antibodies in the specification at page 69, line 7 in the prior Amendment. In particular, the Examiner found that the amendatory material was considered new matter because it was not accompanied by an affidavit or declaration stating that it consists of the same material incorporated by reference. Applicants believed that the relevant statements in the Remarks section of the previous amendment, above the signature of Applicants' representative, would address the Examiner's concerns. However, as it appears that this amendment was not entered previously, it is re-presented here.

In addition, a declaration as required by the Examiner is submitted herewith, captioned Declaration by Andrew N. Merickel, Ph.D. The declaration states that the amendment to the specification beginning on page 69, line 7, which is relevant to testing molecules for their ability to modulate body weight, fat-depot weight and food intake, is the same material which is cited and incorporated by reference from Levin et al. (Proc. Natl. Acad. Sci. USA 93:1726-1730 (1996)). In view of the Declaration, Applicants respectfully submit that the amendment does not introduce new matter and request entry of the amendment and withdrawal of this rejection.

In addition, claims 1, 3-8, 11-12, 22 and 25-29 stand rejected under 35 U.S.C. §112, first paragraph, because the Examiner believes that the Claims are enabled only for *ob/ob* mice and not for any obese animal. Without acquiescing in the Examiner's position, claim 1 has been

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amended such that it no longer refers to reduction of body weight in an obese animal. Thus, Applicants respectfully request withdrawal of this rejection.

**Rejection under 35 U.S.C. §102 (e)**

Claims 1-8, 11-12, 22, and 25-29 stand rejected because the Examiner believes that they are anticipated by Tartaglia et al. (US Patent 5,972,621). Claim 1 has been amended to include the step of selecting agonist antibodies with a  $K_d$  of no more than  $1 \times 10^{-7}$ . Tartaglia et al. does not teach or suggest selecting agonist antibodies with a particular affinity for the extracellular domain within SEQ ID NO: 2. Thus, Applicants request withdrawal of this rejection.

**Conclusion**

For the reasons set forth above, it is respectfully submitted that the present Application is in condition for allowance. Should any issues remain, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 31, 2003

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